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TO: Examiner S. Hui  
US Patent and Trademark Office

OCT 28 2003

DATE: October 28, 2003

REFERENCE: US Patent Application No. 10/091, <sup>222</sup>~~122~~

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- (i) One (1) page Transmittal Letter; and
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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application Number	10/091,222										
		Filing Date	March 1, 2002										
		First Named Inventor	Grubb et al.										
		Group Art Unit	1617										
		Examiner Name	S. Hui										
Total Number of Pages in this Submission	5	Attorney Docket Number	AHPWA16BUSA										
<b>ENCLOSURES (check all that apply)</b>													
<table border="1"> <tr> <td> <input type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input checked="" type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53         </td> <td> <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____         </td> <td colspan="2"> <input type="checkbox"/> After Allowance Communication to a Technology Center  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input type="checkbox"/> Other Enclosure(s) (please identify below):         </td> </tr> <tr> <td colspan="3">Remarks</td> <td colspan="2"></td> </tr> </table>					<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to a Technology Center <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):		Remarks				
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to a Technology Center <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):											
Remarks													
<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>													
Firm or Individual Name	Cathy A. Kodroff, Esquire Howson and Howson												
Signature	<i>Cathy A. Kodroff</i>												
Date	October 28, 2003												
<b>CERTIFICATE OF TRANSMISSION/MAILING</b>													
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date: <u>10/28/03</u>													
Typed or printed name	<i>Penny R. Spive</i>												
Signature	<i>Penny R. Spive</i>	Date	October 28, 2003										

This collection of information is required by 37 CFR 1.55. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 USC 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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Customer No. 38199

AHPWA16BUSA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Grubb et al.

Appln. No. 10/091,222

Filed: March 1, 2002

For: CONTRACEPTIVE METHODS  
USING BENZIMIDAZOLONES

) Group Art Unit: 1617

) Examiner: S. Hui

) October 28, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE UNDER 35 USC § 121

Sir:

This paper is in timely response to the Office Action dated October 2, 2003.

Please enter the following elections.

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on 10/28/03  
Date

Frederic R. Spence  
Signature

Frederic R. Spence

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## ELECTIONS

### Election of the Claims

The Examiner has restricted Applicants' invention into four (4) groups and required that Applicants elect the claims of one (1) of said four groups.

In response to the requirement to elect the claims of one (1) group, Applicants hereby elect the claims of group I, i.e., claims 1-24, 33, and 34, drawn to a method of contraception including administration of a progestational agent, ethinyl estradiol and an antiprogestin agent in three phases, where the first phase includes administration of a progestational agent and ethinyl estradiol, and the second includes administration of an antiprogestin agent without prejudice.

Applicants have canceled the non-elected claims of groups II-IV, i.e., claims 25-32, and reserve the right to prosecute the non-elected claims in a divisional application filed during the pendency of the present application.

### Species Election

The Examiner has asserted that claims 1-5 and 28-39 are generic to a plurality of patentably distinct species of antiprogestins and has required that a single disclosed species of an antiprogestin compound be elected.

In response to the requirement to elect one (1) antiprogestin agent of formula I, Applicants hereby elect the compound of claim 7, i.e., 1-benzyl-6-(3-nitro-phenyl)-1,3-dihydro-benzoimidazol-2-one, without prejudice.


REMARKS

After entry of this response, claims 1-34 are pending. Claims 1-24, 33, and 34 are elected, without prejudice, as noted above.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees to our Deposit Account Number 08-3040.

Respectfully submitted,

HOWSON AND HOWSON  
Attorneys for Applicants

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